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FAX NO.: (703) 872--9306 PAGES: // (including cover page)

DATE: March 22, 2004

TIME: 7:15 P.M.

SUBJECT: Response to Office Action mailed February 19, 2004

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MAR 24 2004

APPLICANT: Sauro Macerini

SERIAL NO.: 09/923,286

FILED: August 6, 2001

FOR: Method For Manufacturing Electrical Components

GROUP ART UNIT: 3729

CUSTOMER NO.: 23456

OUR DOCKET NO.: N6811

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Examiner: Donghai D. Nguyen
Attorney's Docket No.: N6811
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OFFICIAL

VIA FACSIMILE NO. 703-872-9306

RESPONSE TO FEBRUARY 19, 2004 OFFICE ACTION

Mail Stop Non Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is being filed in response to the Office Action mailed February 19, 2004.

Examiner's response to applicant's December 15, 2003 response and amendment

In the Office Action mailed February 19, 2004, the Examiner indicates that the response and amendment filed by the applicant on December 15, 2003 ("the December amendment") was non-responsive. The Applicant respectfully disagrees and requests that the Examiner enter the December amendment as filed.

In support of his position, the Examiner provides several arguments. First, the Examiner argues that the December amendment canceled "all claims drawn to the elected invention" and presented "only claims drawn to a non-elected invention" and

cites MPEP §821.03. Second, the Examiner indicates that the claims in the December amendment "are not readable on the elected invention because the scope of the original claims 1-19 is not presented in the newly added claims 67-90." Third, the Examiner argues that "it is clearly [sic] that the subject matters [sic] of [sic] as recited in these newly added claims are not recited in the originally rejected claims 1-19." The Examiner does not cite any authority for his second and third arguments. Next, the Examiner indicates that the "Office generally does not permit shift [sic] of elected subject matter" and cites MPEP §819. Finally, the Examiner indicates that "the newly added claims are directed to many distinct species." The applicant will address each one of these arguments in turn.

The December amendment includes claims drawn to the elected invention

Contrary to the Examiner's statements otherwise, the Applicant's December amendment does, in fact, include claims that are directed to the elected invention. The elected invention is shown in Figs. 1-14 and Claims 67-80 included in the December amendment are clearly directed to that invention.

The elected invention is shown in Figs. 1-14

In an Office Action mailed December 11, 2002, the Examiner indicated that the pending application included two inventions, an electrical component and a method of producing an electrical component, and required the applicant to restrict the application to one of those inventions. Office Action mailed December 11, 2002, p. 2. In response to this restriction requirement, the applicant restricted the application to

the invention relating to the method of producing an electrical component. Applicant's Response and Amendment mailed January 13, 2003, p. 2.

In that same office action, the Examiner also indicated that the pending application included four patentably distinct species of the claimed invention and required the applicant to elect a single disclosed species for prosecution on the merits in case no generic claim is finally held to be allowable. As indicated by the Examiner, the four species were shown in Figs. 1-14, 15, 16-20, and 21-30. Office Action mailed December 11, 2002, p. 3. In response to this requirement, the applicant elected the species of the invention shown in Figs. 1-14. Applicant's Response and Amendment mailed January 13, 2003, p. 2.

In the Examiner's next Office Action, the Examiner acknowledged the applicant's election of the invention relating to the method of producing an electrical component and the species of that invention shown in Figs. 1-14. Office Action mailed April 3, 2003, p. 2.

Thus, the elected invention in this case is the species of the method of producing an electrical component that is shown in Figs. 1-14.

Claims 67-80 are directed to the elected invention

Turning now to the issue of whether any of the claims in the December amendment read on this elected invention, the applicant submits that newly submitted Claim 67 clearly reads on the species shown in Figs. 1-14. Claim 67 is directed to a method of producing an electrical component that includes the steps of

providing a container having an exterior surface, an inner space, and an open base, providing a plurality of electrically conductive half-turns, and connecting the plurality of electrically conductive half-turns to the exterior surface of the container. As explained in detail in the specification of the pending application at pages 9-15, Figs. 1-2 clearly show a container 1 having an exterior surface (no reference number), an inner space 3, and an open base, and Figs. 4-8, 10-12, and 14 show a plurality of electrically conductive half-turns 8 connected to the exterior surface of the container 1. As a result, Claim 67 reads on the invention elected by the applicant.

Claims 68-80 are dependent claims that depend from Claim 67 and include all its limitations, including the limitations referenced above that cause Claim 67 to read on the elected invention. Consequently, these dependent claims read on the elected invention as well.

MPEP §821.03

The Examiner cites MPEP §821.03 in support of his argument that canceling all claims drawn to an elected invention and presenting only claims drawn to a non-elected invention causes an amendment to be nonresponsive. Applicant does not dispute this fact. As indicated above, however, applicant has not presented claims drawn only to a nonelected invention. Claims 67-80 are clearly directed to the elected invention. And, as required by §821.03 cited by the Examiner, these claims should be examined. MPEP §821.03 ("Of course, a complete action on all claims to the elected invention should be given.")

The claims in the December amendment do not have to read on original Claims 1-19 in order to read on the elected invention

The Examiner suggests that the newly submitted claims must read on original Claims 1-19 in order to read on the elected invention. In the Office Action mailed February 19, 2004, the Examiner wrote "The remaining claims are not readable on the elected invention because the scope of the original claims 1-19 is not presented in the newly added claims 67-90." The meaning of the phrase "the scope ... is not presented" was unclear to the applicant, and, as a result, applicant contacted the Examiner to determine its meaning. During several different telephone conferences, the Examiner indicated that this phrase meant that the newly submitted claims must somehow read on original Claims 1-19. Applicant disagrees.

The applicant has reviewed the MPEP and is unable to find any authority supporting the Examiner's position in this regard. In addition, the Examiner has not cited any authority supporting this position. Accordingly, the applicant submits that the newly submitted claims do not have to read on original Claims 1-19 in order to read on the elected invention.

If the Examiner is aware of any authority that supports this position, the applicant respectfully requests that the Examiner identify that authority for the applicant.

The claims in the December amendment do not have to recite the same subject matter that is recited in original Claims 1-19 in order to read on the elected invention

The Examiner suggests that the newly submitted claims must recite the same subject matter that is recited in original Claims 1-19 in order to read on the elected invention. Office action mailed February 19, 2004, p. 2 ("It is clearly [sic] that the subject matters [sic] of [sic] as recited in these newly added claims are not recited in the originally rejected claims 1-19.") Once again, Applicant disagrees.

The applicant has reviewed the MPEP and is unable to find any authority supporting the Examiner's position. Furthermore, the Examiner has not cited any authority that might support this position. Consequently, the applicant submits that the newly submitted claims do not have to recite the same subject matter as that recited in original Claims 1-19 in order to read on the elected invention.

If the Examiner is aware of any authority that supports the Examiner's stated position, the applicant respectfully requests that the Examiner identify that authority for the applicant.

The applicant has not improperly shifted the elected subject matter in violation of MPEP §819 as suggested by the Examiner

In the February 19, 2004 Office Action, the Examiner suggests that the applicant has improperly shifted the elected subject matter by submitting Claims 67-90. Office action mailed February 19, 2004, p. 2 ("Note the Office generally does not permit shift [sic] of elected subject matter (See section 819 of the MPEP)"). The

Applicant has not improperly shifted the elected subject matter in this application by submitting these new claims.

As indicated above, the elected invention, or elected subject matter, is the method of producing an electrical component shown in Figs. 1-14 and new claims 67-80 clearly read on this invention. Thus, the submission of these claims has not improperly shifted the elected subject matter in this application.

Claims 81-90 also do not improperly shift the elected subject matter in this application. Claims 81-90 are directed to methods of producing electrical components that are shown in Figs. 15-20. While these claims are directed to subject matter that has not been elected, the inclusion of these claims is not improper.

New claim 67 is an allowable generic claim that reads on the elected species shown in Figs. 1-14 and the two additional species of the invention shown in Figs. 15-20. As a result, the applicant is entitled to submit claims covering the species shown in Figs. 1-14 and 15-20. MPEP §820 ("Where a genus is allowed, applicant may prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141. *This does not constitute a shift.*") (emphasis added); 37 C.F.R. §1.141 (...more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims ... provided the application also includes an allowable claim generic to all the claimed species...). Claims 67-80 cover the species shown in Figs. 1-14 and Claims 81-90 cover the two species shown

in Figs.15-20. Therefore, the applicant submits that Claims 81-90 do not improperly shift the elected subject matter of the present application.

The fact that the newly added claims 67-90 are directed to many distinct species does not make the December amendment nonresponsive

Finally, the Examiner suggests that the fact that the newly added Claims 67-90 are directed to many distinct species somehow supports the position that the applicant's December amendment is nonresponsive. Office action mailed February 19, 2004, p. 2 ("Furthermore the newly added claims are directed to many distinct species.").

The Examiner's position in this regard is unclear and the applicant respectfully requests that the Examiner clarify his position. Applicant is unaware of any authority that indicates that an amendment is nonresponsive because it includes claims directed to many distinct species. Furthermore, as indicated above, Claims 67-80 are directed to the elected invention and Claims 81-90 are permissible species claims because Claim 67 is an allowable generic claims that reads on the three species covered by Claims 67-90.

Miscellaneous

Applicant has commented on the claims to facilitate a better understanding of the present invention. This discussion is not exhaustive of the facets of the invention, and Applicant hereby reserves the right to present additional distinctions as appropriate. Furthermore, while these remarks may employ shortened, more specific,

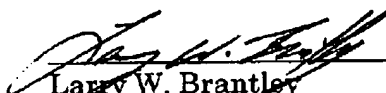
or variant descriptions of some of the claim language, Applicant respectfully notes that these remarks are not to be used to create implied limitations in the claims and only the actual wording of the claims should be considered in order to determine the scope of the claims.

The Commissioner is authorized to charge any deficiency or credit any overpayment associated with the filing of this response to Deposit Account 23-0035.

CONCLUSION

Applicant respectfully submits that the December amendment was responsive and specifically requests that the Examiner enter that amendment in this case and consider newly submitted Claims 67-90.

Respectfully submitted,



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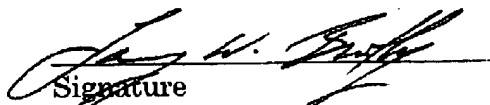
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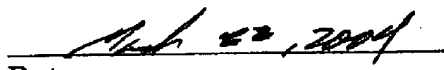
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this response is being facsimile transmitted to the United States Patent and Trademark Office via facsimile number, 703-872-9306, on March 22, 2004.

Larry W. Brantley


Signature
Registration Number 46,052


Date